

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

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| In Re Application of: |) | |
| |) | |
| Michael D. Zoeckler |) | Examiner: Harmon, Christopher R. |
| |) | |
| Serial No.: 09/559,704 |) | Art Unit: 3721 |
| |) | |
| Filed: April 27, 2000 |) | Confirmation No.: 2557 |
| |) | |
| For: PAPERBOARD CARTONS WITH |) | |
| LAMINATED REINFORCING RIBBONS |) | |
| AND TRANSITIONED SCORES AND |) | |
| METHOD OF MAKING SAME |) | |

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REPLY BRIEF

Sir:

This Reply Brief is filed pursuant to 37 CFR 41.41, in response to the Examiner's Answer dated October 23, 2009.

The appealed claims stand rejected on the following grounds:

- (1) Claims 1, 3, 5-7, 11, 13, 25, 31-33 and 77, anticipated by *Walsh* (U.S. Patent 5,746,871) (*Walsh*), under 35 U.S.C. § 102(b).¹
- (2) Claims 1, 3, 5-7, 11, 13, 25, 31-33 and 77, unpatentable over *Walsh*, under 35 U.S.C. § 103(a).
- (3) Claims 9 and 10, unpatentable over *Walsh* in view of *Decottignies et al.* (U.S. Patent No. 5,097,651) (*Decottignies*), under 35 U.S.C. § 103(a).
- (4) Claims 2, 14, 15 and 26-28, unpatentable over *Walsh* in view of *McNown* (U.S. Patent No. 5,447,270) (*McNown*), under 35 U.S.C. § 103(a).

¹ Although Applicant pointed out in the Appeal Brief (footnote 1) that claim 3 was not included in any of the grounds of rejection, the Examiner still has not included it. For the purpose of this appeal, Applicant will continue to assume that the Examiner intended to include claim 3 in grounds of rejection (1) and (2).

(5) Claims 78-81, unpatentable over *Walsh* in view of *Meyers* (U.S. Patent No. 4,177,715) (*Meyers*), under 35 U.S.C. § 103(a).

For the reasons discussed in the Appeal Brief filed on September 21, 2009, Applicant contends that the rejections are not well taken, and requests that they be reversed. However, the Board is requested also to consider the following remarks, which are submitted in response to assertions and arguments presented in the Examiner's Answer.

It is noted initially that on page 8 of the Answer, the Examiner cites three U.S. patents (Mathieu et al., No. 6,015,084; Balin, No. 4,905,864; and Knecht, No. 5,393,295). None of these references form the basis of any rejection under appeal. Although Applicant does not consider that these patents are any more relevant than the prior art applied by the Examiner in the above-listed grounds of rejection, Applicant objects to the citation of these patents in the Answer, since they are not positively included in any of the stated grounds of rejection. In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970); Ex parte Raske, 28 USPQ2d 1304, 1305 (BPAI 1993).

Before discussing the grounds of rejection individually, it is worth noting that the Examiner continues to exhibit a fundamental misunderstanding of the function performed by *Walsh's* ribbons (strips) 6. Even if, as stated by the Examiner on page 7 of the Answer, the ribbons 6 would "inherently provide additional structural reinforcement", the purpose of the ribbons, as discussed by Applicant on pages 6 and 7 of the Appeal Brief, is not reinforcement, but rather to prevent portions 64 of the paperboard web 2 from adhering to film 10. The Examiner's failure to acknowledge the intended purpose of *Walsh's* ribbons pervades the rejections in this case and renders them untenable.

Ground (1): Anticipation by *Walsh*

On pages 7-13 of the Appeal Brief, Applicant explained how *Walsh* does not anticipate independent claims 1 and 25, because *Walsh* does not disclose at least the claimed limitations of (i) longitudinal fold lines in the web, and (ii) ribbons which do not extend across longitudinal fold lines.

Apparently with regard to limitation (i), the Examiner states that "*Walsh* clearly depicts longitudinal fold lines as noted supra" and that "The web is advanced as claimed" (Answer, page 7). However, as pointed out in the Appeal Brief (page 7), although *Walsh* discloses an advancing web, it does not disclose longitudinal fold lines 54 in the advancing web. As far as can be

determined, it appears rather that in the *Walsh* process, ribbons 6 are applied to the advancing web 2 (see Fig. 1 and col. 3, lines 5-11), and then fold lines 54 are formed when the carton blank (Fig. 5) is formed. This is contrary to independent claims 1 and 25, which recite that the advancing web of noncorrugated paperboard has panel portions separated by longitudinal fold lines, and the ribbons are adhered or laminated to the advancing web.²

As for limitation (ii), Applicant has explained in detail on pages 8-13 of the Appeal Brief not only why it is not inherent in the *Walsh* process that the ribbons do not extend across the longitudinal fold lines, but moreover why one of ordinary skill in the art would conclude that they do extend. The Examiner, however, contrary to precedent cited in the Appeal Brief,³ maintains that the claims are anticipated by *Walsh* even though he states that “The disclosure [of *Walsh*] is not clear as to the exact positioning of the ribbons of reinforcing material with respect to fold lines 54” (Answer, page 4). Since there can be no anticipation by inherency unless “the missing descriptive material is ‘necessarily present,’ not merely probably or possibly present, in the prior art,” *Trinitec Industries, Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002) (citing *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)), Applicant cannot understand how a claimed feature can be “necessarily present” in a reference when according to the Examiner it is “not clear” whether the reference discloses that feature.

On page 8 of the Answer, the Examiner draws an inference that *Walsh*’s ribbons (strips) 6 do not cross longitudinal fold lines 54 from the fact that *Walsh* discloses that fold lines 54 are formed in material 2, but fails to mention that they are formed in ribbons 6. However, no conclusion can be drawn from this “non-disclosure”, because *Walsh* also does not mention that fold lines 54 are formed in film 10, even though film 10 covers the entire width of the web 2, including fold lines 54.

Ground (2): Obvious over *Walsh*

First, concerning limitation (i) above, the Examiner entirely fails to assert that it would have been obvious to provide longitudinal fold lines in the advancing web 2 of *Walsh*.

² On page 7 of the Answer, the Examiner mistakenly states that Applicant is relying on the unclaimed feature of “performing a folding process prior to adhering ribbons of reinforcing material”. Applicant is not relying on any such feature, nor could he, since Applicant’s disclosed process specifies that the ribbons are adhered to the web before carton blanks are formed from the web and folded into cartons.

³ *In re Lind*, 264 F.2d 914, 916, 121 USPQ 222, 223 (CCPA 1959); *In re Turley*, 304 F.2d 893, 899, 134 USPQ 355, 360 (CCPA 1962)

Regarding limitation (ii) above, the incorrectness of the Examiner's conclusion as to why it would have been obvious not to extend the *Walsh* ribbons 6 beyond the longitudinal fold lines was addressed fully on pages 13-15 of the Appeal Brief. The Examiner's position seems to be that it would have been obvious not to extend the so-called "reinforcing ribbons" of *Walsh* across the longitudinal fold lines in order to avoid folding problems, but what the Examiner does not recognize is that *Walsh*'s ribbons 6 are not provided for the purpose of reinforcement, and, as demonstrated in the Appeal Brief, in order to perform their intended function of preventing the film 10 from adhering to the paperboard 2, they must cross the longitudinal fold lines. In this regard it is well settled that "If [the] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)". MPEP 2143.01, part V. If the *Walsh* method were modified as proposed by the Examiner, the ribbons 6 would no longer perform the function for which they are provided; therefore, the proposed modification of *Walsh* would not have been obvious.

Accordingly, independent claims 1 and 25, together with dependent claims 3, 5-7, 11-13, 31-33 and 77, are patentable over *Walsh*. Likewise, the remaining dependent claims on appeal, i.e., 2, 9, 10, 14, 15, 26-28 and 78-81, are patentable, since the *Decottignies*, *McNown* and *Meyers* references do not overcome the deficiencies of *Walsh*.

Ground (3): *Walsh* in view of *Decottignies*

The Examiner's response to Applicant's arguments concerning this ground of rejection (Appeal Brief, pages 15-16) is that they are "merely speculative". Citing *KSR Int'l. Inc. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007), the Examiner states that "one must ask whether the improvement is more than the predictable use of prior art elements according to their established functions" (Answer, page 9). Insofar as this question relates to the proposed combination of *Walsh* and *Decottignies*, the answer is "yes". The "established function" of *Decottignies*' printed indicia is to function as a label on the exterior of the container. This is not a "predictable use" insofar as it relates to the ribbons 6 of *Walsh*, since, as discussed on page 15 of the Appeal Brief, it is inapplicable to the *Walsh* ribbons. Moreover, as noted on pages 15-16 of the Appeal Brief, even if *Walsh* were modified as proposed by the Examiner, claim 9 (and claim 10) would still not be met.

Ground (4): *Walsh* in view of *McNown*

The Examiner's argument with respect to this ground of rejection, as expressed on pages 9-10 of the Answer, again appears to be predicated upon his view that *Walsh*'s ribbons 6 are "reinforcing ribbons", without recognizing that if the ribbons were positioned so as to not extend across the longitudinal fold lines, their disclosed functionality would be destroyed. Therefore, the fact that *McNown* may disclose "reinforcing longitudinal panel portions by reinforcing only adjacent portions of a score line" does not provide a teaching which one of ordinary skill would consider to be applicable to the process of *Walsh*.

Ground (5): *Walsh* in view of *Meyers*

This ground of rejection is not sustainable, since *Meyers* does not overcome the above-discussed deficiencies of *Walsh*.

Conclusion

For the reasons given above and in the Appeal Brief, the subject matter of the appealed claims is not unpatentable over the grounds of rejection applied by the Examiner in the Office action of May 19, 2009. It is therefore respectfully requested that the rejections of claims 1-3, 5-7, 9-11, 13-15, 25-29, 31-33 and 77-81 be reversed.

The Commissioner is hereby authorized to charge any fees that may be required for the timely consideration of this Reply Brief to Deposit Account No. 09-0528.

Respectfully submitted,



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